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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

GARBE, STEPHEN P

ART UNIT PAPER NUMBER

3727

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,434

Applicant(s)

MAIN ET AL.

Examiner

Stephen Garbe

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-12,14-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-12,14-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 6, 2003, has been entered.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is nothing in the original disclosure which provides support for the claim limitations that the bag sides and front and back panels comprise a plurality of layers of paper. The only disclosure of the number of layers is on page 4 of the written description which states that the bag may be made from "a single large piece of paper." This statement indicates that only a single paper layer was contemplated by the inventors as of the filing date of this application. This is a new matter rejection.

4. The drawings are objected to under 37 CFR 1.83(a) as failing to illustrate the plurality of layers recited in claims 19 and 21. No new matter may be entered in response to this objection.

Art Unit: 3727

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent for "the first and second opposing sides" and it cannot be determined what this limitation refers to since the only "opposing" elements previously recited were "first and second opposing panels" and "first and second opposing side panels."

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 4, 7, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroemer, United States Patent No. 1,713,341 in view of either Fox et al., United States Patent No. 6,024,489 (Fox) or Cammack, United States Patent No. 5,741,076 and further in view of Onderdonk, United States Patent No. 318,016.

Kroemer teaches a paper bag which is to be hung from a spindle by means of an aperture 21. Note Figure 1 which illustrates a back panel having an aperture 21 and a front panel having a cut-away portion for exposing the aperture. The bag further includes a slit 22 extending from the aperture to the top edge of the bag for the purpose of facilitating the removal of the bag from the spindle. Aperture 21 has a non-

continuous perimeter. In addition, Kroemer's bag does not have left and right side panels.

Cammack discloses a bag which is to be hung from a pair of spindles which extend through apertures 78. Apertures 78 have continuous perimeters. Cammack further discloses slits 79 which extend from the top edge of the bag toward aperture 78 for the purpose of facilitating the removal of the bag from the spindles. See col. 4, lines 59-61.

Fox discloses a bag having apertures 30 extending through one wall of the bag for the purpose of mounting the bag on a pair of wicket pins. Apertures 30 have continuous perimeters. Fox further discloses slits 40 which extend from the top edge of the bag toward apertures 30 for the purpose of facilitating the removal of the bag from the wicket pins. See col. 4, lines 52 and 53.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kroemer's aperture and slit arrangement to provide an aperture with a continuous perimeter and a slit extending from the top edge of a bag wall toward, but stopping short of, the aperture, as taught by either Cammack or Fox, because Cammack's and Fox's aperture and slit arrangements are equivalent to Kroemer's aperture and slit arrangement.

It would have been further obvious to provide Kroemer's bag with side panels, as taught by Onderdonk, because Kroemer's bottom wall has four sides and, thus is capable of forming the bottom of a bag having four sides. Furthermore, providing

Kroemer's bag with left and right side walls would have provided additional space for contents.

The term "bale" as a modifier of the claimed bag and the statement of intended use impart no structure to the claimed bag and do not define over the prior art.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1, and further in view of Lawford, Australian Published Patent Application Number 113, 542. It would have been obvious to provide Kroemer's bag with ventilation openings in the front and back panels, as taught by Lawford, because such openings would have allowed Kroemer's bag to be used for packaging items needing ventilation.

10. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1. Furthermore, the various claimed sizes and shapes would have been obvious matters of choice.

11. Claims 12, 14, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroemer, United States Patent No. 1,713,341 in view of either Fox et al., United States Patent No. 6,024,489 (Fox) or Cammack, United States Patent No. 5,741,076 and further in view of Onderdonk, United States Patent No. 318,016. It would have been obvious to modify Kroemer's bag in view of either Cammack or Fox and further in view of Onderdonk, for the reasons set forth above. Such modifications would have resulted in all of the claimed method steps except for the steps related to forming the bag bottom. It would have been obvious to form Kroemer's bag with left and right side panels and bottom flaps in the manner taught by Onderdonk because Onderdonk's

method is a convenient method for making a bag. The term "bale" as a modifier of the claimed bag and the statement of intended use impart no structure to the claimed bag and do not define over the prior art.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 12 and further in view of Lawford, Australian Published Patent Application Number 113, 542. It would have been obvious to provide Kroemer's bag with ventilation openings in the front and back panels, as taught by Lawford, because such openings would have allowed Kroemer's bag to be used for packaging items needing ventilation.

13. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to their respective parent claims. It would have been an obvious matter of choice to provide Kroemer's bag with a plurality of layers because multi-layer bags and their uses and the functions of the various layers are old and well-known.

14. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

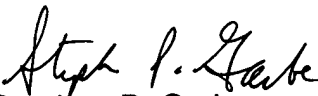
15. Any inquiry concerning this application or proceeding should be directed to Stephen Garbe who can be reached at 703-308-1207. The examiner can normally be reached Monday-Thursday between the hours of 7:15 and 4:45 and alternate Fridays between the hours of 7:15 and 3:45.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on 703-308-2572.

Art Unit: 3727

17. The fax phone numbers for Technology Center 3700 are 703-872-9302 for papers filed in response to a non-final Office Action and 703-872-9303 for papers filed in response to a Final Office Action.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is 703-308-1148.


Stephen P. Garbe
Primary Examiner
Group 3720